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|-----------------|-------------|----------------------|---------------------|
| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
| 097318,045      | 05/21/99    | DESCROCHELLE         | 10575-27            |

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| EXAMINER |
| LEE, B   |

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
| 1032     |              |

DATE MAILED:

07/21/00

Please find below and/or attached an Office communication concerning this application r proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/316,048

Applicant(s)

Desgroselliers et al.

Examiner

Gai (Jennifer) Mi Lee

Group Art Unit

1632



- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

- ☒ Claim(s) 1-18 \_\_\_\_\_ is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claims 1-18 \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-3 and 13-18 are drawn to a polypeptide or recombinant protein isolated Staufen protein or C. Elegus Staufen protein, classified in class 530, subclass 350+.
  - II. Claims 4-8 are drawn to a polynucleotide sequence of at least 95% identity, recombinant vector, host and method of making the protein, classified in class 536, subclass 23.1; class 536, subclass 23.5; class 435, subclass 328; and class 435, subclass 69.1.
  - III. Claims 9-11 are drawn to a method of treating using a polypeptide or recombinant protein isolated Staufen protein or C. Elegus Staufen protein, classified in class 514, subclass 2.
  - IV. Claims 9-11 are drawn to a method of treating using a polynucleotide encoding a Staufen protein and/or antisense, classified in class 514, subclass 44.
  - V. Claims 9-11 are drawn to a method of treating using a modulator, classified in class 435, subclass 69.2.
  - VI. Claim 12 are drawn to antibody, classified in class 530, subclass 387.3.

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Claims 9-11 are generic to groups III and V. Should either of groups III, IV or V be elected, claims 9-11 will be examined to the extent that they encompass the elected subject matter.

2. The inventions are distinct, each from the other because of the following reason:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the protein can be made by a materially different process such as via chemical synthesis, or it can be prepared from nature using various isolation/purification/chromatographic processes.

Furthermore, it is further pointed out that although there are no provisions under the section for "Relationship of Inventions" in MPEP 806.05 for multiple/different products, restriction is deemed to be proper because the products appear to constitute patentably distinct inventions. Each of the products of Groups I and II, as well as the products of Group VI encompass products (DNA, protein and antibody) that are structurally physically and functionally distinct, and if determined to be patentable they would also be patentably distinct. These groups are not required one for the other. For example the DNA can be used other than to make the protein such as it's use as a probe or the use in other diagnostic processes. In a similar manner the protein or DNA do not require the antibody. Also the protein can be used other than to make

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the Ab or in the process of Groups III, IV or V such as in various therapeutic methods or it can be used in various diagnostics.

Inventions I and III or VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the protein, as claimed, can be used in a materially different processes, such as their use in the various therapeutic processes, or they can be used as probes or in various diagnostic procedures. Further, these groups are not required one for the other.

In a similar manner it is further pointed out that although there are not provisions under the section of "Relationship of Inventions" in MPEP 806.05 for multiple/different methods, restriction is deemed to be proper because the methods appear to constitute patentably distinct inventions. The methods of Group II (process of making the protein), and of Groups III, IV and V are distinct and not required one for the other, nor are these various methods usable with the various products of Groups I, II and VI because they are different elements/agents and steps, and the starting material and final outcomes of each are different.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications, as the searches are not coextensive; and these are different issues for the search and examination of each which would be unduly burdensome. Accordingly, restriction for examination purposes as indicated is proper.

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3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gai (Jennifer) Mi Lee whose telephone is (703) 306-5881. The examiner can normally be reached on Monday-Thursday from 9:00 to 5:30 (Eastern time). The examiner can also be reached on alternate Fridays.  
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jasmine Chambers, can be reached on 703-308-2035. The FAX phone numbers for group 1600 are 703-308-4242 and 703-305-3014.  
An inquiry of a general nature or relating to the status of the application should be directed to the group receptionist whose telephone number is 703-308-0196.

**Gai (Jennifer) Mi Lee**  
**Patent Examiner**  
**Group 1600**

*Gai Mi Lee*  
*Patent Examiner*  
*1632*